REMARKS

Claims 1-4, 7-12, 14, 16, 17, 19-22, 25-30, 32, 34 and 39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (U.S. Pub. No. 2003/0208429 A1) in view of Tolopka (U.S. Patent No. 6,064,076). Bennett discloses a system and method for managing a portfolio with a variety of means to calculate probabilistic risk/benefit measures of portfolios and tools for group decision-making. (Bennett, Abstract). Tolopka discloses a scheduling system that includes detection circuitry for determining whether an individual is present in his office and further includes a scheduling processor that analyzes received schedule criteria and data to determine whether the schedule criteria are satisfied. (Tolopka, Abstract). It is important to note that all queries sent by Tolopka are sent between computers. As Tolopka states:

> Once a query has been received by participant registration *software* 210 at a *computer* 101-105, the registration software 210 will determine whether the desired participant is available.
> ... Such an inferential determination is made *without directly querying the individual* about his or her availability and without requiring the individual to directly divulge his or her schedule.

Tolopka, col. 3, lines 30-41, emphasis added.

Applicant claims a computer implemented method and a computer program product to implement the method having the following limitations:

> maintaining identification for a group of decision-making entities in a memory device;
> maintaining a setpoint representing a minimum cumulative support required to implement a proposed action;
> communicating a query to the plurality of decision-making entities, wherein the query includes a description of the proposed action;
> receiving responses to the query from the plurality of decision-making entities, wherein each response includes an indicator of support for the proposed action;
> determining the cumulative support from the query responses received; and
> automatically implementing the proposed action if the cumulative support is greater than the setpoint.

Patent Application, Claim 1.

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To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 291 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The Federal Circuit has made clear that all claim limitations must be considered and that it is impermissible to merely consider the "idea" of an invention. In *Jones v. Hardy*, 727 F.2d 1524 (Fed. Cir. 1984), the Federal Circuit stated:

> Under the patent statute, Title 35 U.S.C., "ideas" are not patentable;
> claimed structures and methods are. Reducing a claimed invention to
> an "idea," and then determining patentability of that "idea" is error.
> Analysis properly begins with the claims, for they measure and define
> the invention.

Id. at 1527 [citations omitted].

An additional requirement for providing a *prima facie* case of obviousness is that the Examiner must provide a basis for combining or modifying the cited references. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

The case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching, suggestion, or motivation to combine prior art references. *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1225, 1232 (Fed. Cir. 1998) ("the Board must identify specifically....the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); and *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]").

Evidence of a suggestion, teaching or motivation to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). The invention must be viewed not with the blueprint

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drawn by the inventor, but in the state of the art that existed at the time. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In the case *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), the Court states:

> Most, if not all inventions arise from a combination of old elements ...
> Thus, every element of a claimed invention may often be found in the
> prior art. However, identification in the prior art of each individual part
> claimed is insufficient to defeat patentability of the whole claimed
> invention. Rather, to establish obviousness based on a combination of
> the elements disclosed in the prior art, there must be some motivation,
> suggestion or teaching of the desirability of making the specific
> combination that was made by the applicant.

Id. at 1395.

Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented because each and every limitation claimed by Applicant has not been taught or suggested by the cited prior art. First, Applicant claims "maintaining identification for a group of decision-making entities in a memory device." (Claim 1, 19). Applicant defines a decision-making entity as "an individual, family, group, corporation, officer, employee, etc. that has registered an interest in participating [in] a decision-making forum. . . (Specification, p. 12, lines 21-23). The Examiner cites Bennett's figure 2-1, showing "job classification," to show that Bennett discloses Applicant's claimed limitation of maintaining identification for a group of decision-making entities. (Office Action, p. 3).

The "job classification" information disclosed by Bennett is not the same as Applicant's claimed limitation of maintaining identification for a group of decision-making entities. As Bennett discloses, "[The Bennett method] optionally can request the user to specify his/her job classification [which] data can be used in the analysis tool to observe whether there is a systemic relationship between responses on projects and types of job." The job classification *data* as disclosed by Bennett is merely a piece of data to be input by the user and then analyzed by Bennett's disclosed method. It is not the claimed limitation of Applicant - maintaining identification for a group of decision-making entities in a memory device. The teaching by Bennett of having the user input a job classification data point does not identify the group of decision-making entities. Inputting job classification information by the user of Bennett's computer program does not suggest or teach "maintaining identification for a group of decision-making entities in a memory device," which is a limitation claimed by Applicant.

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Because Bennett does not disclose Applicant's claimed limitation of maintaining identification for a group of decision-making entities in a memory device, Applicant respectfully asserts that a *prima facie* case of obviousness, which requires that each and every claimed limitation must be taught or suggested by the prior art, has not been presented. Therefore, reconsideration and withdrawal of the rejection of claims 1 and 19, and all claims depending therefrom, including claims 2-4, 7-12, 14, 16, 17, 20-22, 25-30, 32, 34 and 39, is respectfully requested.

Applicant further claims maintaining a setpoint representing a minimum cumulative support required to implement a proposed action and automatically implementing the proposed action if the cumulative support is greater than the setpoint. (Claims 1, 19). The Examiner cites ¶ 0130-0132 and 136-137 of Bennett as disclosing, teaching or suggesting this claimed limitation. Bennett discloses that individuals may select from a list of projects a specified number of projects that they think should be performed and a specified number that they think should not be performed. (Bennett, ¶ 0130). Bennett further discloses that the method then collates the accept and reject data from any number of participants and *allows individuals or a group* to rank, sort and split the projects into different groups in a variety of ways. *Id.*, emphasis added. As Bennett further discloses, "the rank-by control allows *users* to rank projects by # of acceptances . . . and by any other data loaded." *Id.*, emphasis added.

Therefore, as shown above, Bennett merely discloses, suggests or teaches that users, individuals or groups may rank projects that appear on a list of possible projects by using information that includes the rankings of the projects by others as well as, for example, a probability of success for each of the projects, the expenses associated with each of the projects, etc. This is not "maintaining a setpoint representing a minimum cumulative support required to implement a proposed action," which is the limitation that is claimed by Applicant. Furthermore, Bennett fails to disclose that any proposed action is *automatically* implemented if the cumulative support is greater than the setpoint, which is a limitation claimed by Applicant. There is no automatic implementation of a project taught or suggested by Bennett. Because Bennett does not disclose the limitation of maintaining a setpoint representing a minimum cumulative support required to implement a proposed action and automatically implementing the proposed action if the cumulative support is greater than the setpoint that is claimed by Applicant, Applicant respectfully asserts that a *prima*

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facie case of obviousness has not been presented.   Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 19, and all claims depending therefrom, including claims 2-4, 7-12, 14, 16, 17, 20-22, 25-30, 32, 34 and 39.

The Examiner states that Bennett does not disclose, teach or suggest Applicant's claimed limitations of "from the query responses received; for communicating a query; responses to the query; and wherein the query includes a description of the proposed action." (Office Action, p. 3). The Examiner cites Tolopka as teaching these limitations. *Id.*

As previously noted, all queries sent by Tolopka are sent between computers, not to a decision making entity. As Tolopka states:

> Once a query has been received by participant registration *software* 210 at a *computer* 101-105, the registration software 210 will determine whether the desired participant is available.
> ... Such an inferential determination is made *without directly querying the individual* about his or her availability and without requiring the individual to directly divulge his or her schedule.

Tolopka, col. 3, lines 30-41, emphasis added.

In fact, Tolopka teaches the advantages of not directly querying an individual. Tolopka seeks to solve the scheduling problem faced by many automatic schedulers - that individuals do not keep their schedules updated.   (Tolopka, col. 1, lns. 20-27).   Tolopka states that a technique for determining potential event schedule times that does not require detailed record keeping by prospective participants is therefore desirable.   *Id.*   Because Tolopka teaches away from communicating to an individual, Tolopka cannot be modified or combined with other references to teach or suggest "communicating a query to the plurality of decision-making entities," which is a limitation claimed by Applicant.

Tolopka does not teach communicating a query to the plurality of decision-making entities, which is a limitation claimed by Applicant. Instead, Tolopka teaches that queries are sent from one computer to another computer, wherein the queried computer then merely reports back the availability of a desired participant. The responding computer does not respond with an indicator of support for a proposed action – merely whether a particular desired participant is available during a given time period. Tolopka fails to teach or suggest Applicant's claimed limitation of receiving

responses to the query from the plurality of decision-making entities, wherein each response includes an indicator of support for the proposed action.

Because Tolopka does not teach or suggest Applicant's claimed limitations of communicating a query to the plurality of decision-making entities and receiving responses to the query from the plurality of decision-making entities, wherein each response includes an indicator of support for the proposed action, Applicant respectfully asserts that a *prima facie* case of obviousness, which requires that each and every claimed limitation must be taught or suggested by the prior art, has not been presented. Therefore, reconsideration and withdrawal of the rejection of claims 1 and 19, and all claims depending therefrom, including claims 2-4, 7-12, 14, 16, 17, 20-22, 25-30, 32, 34 and 39, is respectfully requested.

Furthermore, the Examiner has failed to present the required evidence of a suggestion, teaching or motivation for combining the cited references as is necessary for showing a *prima facie* case of obviousness. The Examiner states that the combination of these references is obvious because "it provides for efficient method for data retrieval and access of records in a database." (Office Action, p. 4).

As the Federal Circuit has held, "Evidence of a suggestion, teaching or motivation to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved." *Pro-Mold & Tool Co.,* 75 F.3d at 1573. The reason for the combination cited by the Examiner, *i.e.,* "it provides for efficient method for data retrieval and access of records in a database," as cited *supra,* does not flow either from the prior art references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. Applicant respectfully asserts that there is no suggestion, teaching or motivation to combine the references as stated by the Examiner because when the references are combined, the result does not address methods for data retrieval and access of records in a database. Instead, the cited references simply use the database tools as they exist in a manner known to those having ordinary skill in the art.

The Examiner has not provided any objective teaching leading to the combination of the cited references and has not specifically identified the reasons one of ordinary skill in the art would have been motivated to select the references and combine them. Therefore, Applicant respectfully asserts

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that a *prima facie* case of obviousness has not been presented and respectfully requests reconsideration and withdrawal of the rejection of claims 1 and 19 and all claims depending therefrom, including claims 2-4, 7-12, 14, 16, 17, 20-22, 25-30, 32, 34 and 39.

The statute requires that, for a showing of obviousness, "the subject matter *as a whole* would have been obvious." 35 U.S.C. 103(a) [emphasis added]. As the Federal Circuit has stated, "Focusing on the obviousness of substitutions and differences instead of on the invention as a whole . . . was a legally improper way to simplify the difficult determination of obviousness." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383 (Fed. Cir. 1986) [emphasis added].

Applicant respectfully assert that the Examiner has lost track of the "subject matter as a whole" and has impermissibly focused on the obviousness of substitutions and differences instead of focusing on the invention *as a whole*. Using impermissible hindsight analysis, the Examiner has scoured the prior art seeking to find the limitations claimed by Applicant without regard either to what the cited references teach or what the Applicant's claimed invention is *as a whole*. As the *Kotzab* court has explained:

> Most, if not all inventions arise from a combination of old elements . . . . Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

In re Kotzab, 217 F.3d at 1395.

The Examiner has focused on finding each of the limitations claimed by Applicant by impermissibly using Applicant's specification as a blueprint and engaging in hindsight analysis. The Examiner has not focused on the subject matter as a whole, which is required by the statute. 35 U.S.C. 103(a). The *Kotzab* court has taught, *supra*, that simply finding a string of elements in the prior art is not enough to defeat patentability. Rather the invention must be looked at as a whole. Because the Examiner has failed to provide references in the prior art that teach or suggest each and every limitation claimed by Applicant, and because the Examiner has failed to examine the claimed invention as a whole, Applicant respectfully asserts that a *prima facie* case of obviousness has not been presented. Therefore, reconsideration and withdrawal of the rejection of claims 1 and 19, and

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all claims depending therefrom, including claims 2-4, 7-12, 14, 16, 17, 20-22, 25-30, 32, 34 and 39, is respectfully requested.

In summary, as Applicant has respectfully asserted in the remarks above, references have not been cited that suggest, teach or disclose each and every limitation claimed by Applicant. Furthermore, the combination of references cited by the Examiner as suggesting or teaching the limitations claimed by Applicant has been the result of the impermissible use of hindsight analysis by the Examiner. Furthermore, there has been no evidence cited by the Examiner of a suggestion, teaching or motivation to combine the references that the Examiner has cited. Additionally, Applicant has respectfully asserted in the remarks above that the Examiner failed to consider what the Applicant has claimed *as a whole*, as required by the statute, but instead impermissibly focused only upon the individual elements claimed by Applicant while using Applicant's specification as a blueprint to identify the elements for which to search in the prior art. As the *Kotzab* court explained, while every element of a claimed invention may be found the prior art, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Kotzab, supra*.

For these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1 and 19 and all claims depending therefrom, including claims 2-4, 7-12, 14, 16, 17, 20-22, 25-30, 32, 34 and 39.

Claims 36-38 stand rejected under 35 U.S.C. 103(a) a being unpatentable over Bennett (U.S. Pub. No. 2003/0208429 A1) in view of Tolopka (U.S. Patent No. 6,064,976) as applied to claims 1-4, 7-12, 14, 16, 17, 19-22, 25-30, 32, 34 and 39 above, and further in view of Lang, *et al.* (U.S. Patent No. 6,694,007 B2). Claims 36-38 are dependant claims that depend from claim 1. As discussed in the remarks above, Applicant asserts that claim 1 is in condition for allowance and therefore, respectfully asserts that claims 36-38 are in condition for allowance since they are dependant claims depending from claim 1. Reconsideration and withdrawal of the rejection is respectfully requested.

Applicant respectfully asserts that all claims are now in condition for allowance and requests

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the issuance of a Notice of Allowance. If the Examiner determines that a telephone interview would expedite the examination of this pending patent application, the Examiner is invited to telephone the below-signed attorney at the convenience of the Examiner. Applicant thanks the Examiner for taking time to discuss this response prior to its filing. This response contains the information discussed during the telephone interview. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 09-0447/IBM/0014, as authorized by the below-signed attorney, in the amount of any necessary fee.

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